

In re: Thomas Zickell
Filed: July 3, 2001
Serial No.: 09/898,707
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REMARKS

This is a complete response to the outstanding Office Action mailed June 28, 2007. Claims 56 and 62 have been amended herein.

Upon entry of the enclosed claim amendments, claims 45-66 remain pending in the present application.

The Applicant traverses all of the objections and rejections of the Office Action. Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

I. Response to new claim objections under 35 USC 112 2nd paragraph

A. Claim 45

Claim 45 recites a composite sheet of rolled roofing material comprising a substrate including a first region and a second region. It is clear that "the substrate of the second region" in reference to lines 13-14 and 15-16 are referring to the substrate disclosed in line 3 and the second region of the substrate disclosed in line 12. If the office wishes to maintain this rejection, Applicant requests the Office cite to specific rules of

English grammar that would allow for another interpretation. The Office Action also recites, "The claim recites that the substrate comprises first and second regions, so the substrate cannot be a component of the "second region." This statement is incorrect. It is inherent that if you divide a substrate in to a first region and a second region than each of the first region and the second region by definition must at least comprise a portion of the substrate.

B. Claims 46 and 56

The Office has rejected claims 46 and 56 for insufficient antecedent basis of "said lower surface of said second region" and "said lower surface of said second portion", respectively for claims 46 and 56. Antecedent basis in claim 46 is provided in line 12 of claim 45 reciting "a second region" and line 15 of claim 45 reciting "a lower surface". Claim 56 has been amended to correct informalities. Antecedent basis in claim 56 is provided in line 4 of claim 55 reciting "a lower surface" and line 13 of claim 55 reciting "a second region of said lower surface". Applicant respectfully requests reconsideration and withdrawal of claim objections.

C. Claims 47 and 48

The Office contends that more than one substrate is disclosed in claim 45. Applicant can only identify antecedent basis for one substrate, in line 3 of claim 45 reciting, "a substrate saturated with a first asphalt composition". No other substrate is

introduced in claims 45, 47, and 48. All other citations of a "substrate" describe "the substrate" first referenced in line 3. Applicant respectfully requests reconsideration and withdrawal of claim objections.

D. Claim 55

Applicant has provided claim language that particularly points out and distinctly defines the metes and bounds of the subject matter. The location of the "first edge" is disclosed throughout claim 55. In lines 8-10, the first edge of the substrate is claimed as being disposed along said first layer. In lines 13-14, the first edge of the substrate is also claimed as being disposed along said second layer. Therefore the first edge of the substrate is disposed along both the first layer and second layer. Applicant claim language particularly points out the first edge of the substrate.

Applicant has provided claim language that particularly points out and distinctly defines the metes and bounds of the subject matter. Applicant has provided language that defines the metes and bounds of the claimed subject matter and is supported by the claim language and the specification. For example, Applicant's claim 55 language may be read on to the original filed figure 1.

"If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and ***an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action.***" See M.P.E.P. 2173.02. The Office has provided no other analysis with regard to what

portion/region and outer/bottom/upper/lower fails to particularly points out and distinctly defines the metes and bounds of the subject matter.

E. Claim 56

Applicant has amended claims 56 to recite, "said upper surface of said first region". Antecedent basis in claim 56 is provided in line 4 of claim 55 reciting "an upper and a lower surface" and lines 8-9 of claim 55 reciting "a first region of said upper surface". Applicant respectfully requests reconsideration and withdrawal of claim objections.

F. Claim 62

Claim 62 has been amended to correct informalities. Amended claim 62 recites, "the second section has" in line 13. Antecedent basis in claim 62 is provided in lines 4-5 of claim 62, which recites, "said substrate having a first section and a second section". Applicant respectfully requests reconsideration and withdrawal of claim objections.

II. Response to claim rejections based on anticipation

In the Office Action, claims 45-47, 52, 55-57, 60, 62, and 63 have been preliminarily rejected as anticipated under 35 U.S.C. § 102(b). Specifically claims 45-47, 52, 55-57, 60, 62, and 63 have been rejected under 35 U.S.C. § 102(b) by U.S. Patent No. 5,096,759 to Simpson et al. (hereinafter, "Simpson").

A. Claim 45

Independent claim 45 reads:

A composite sheet of rolled roofing material comprising:

a substrate saturated with a first asphalt composition, said substrate ***including:***

 a first region having

 an second asphalt composition layer contacting an upper surface of the substrate of the first region and granules contacting an upper surface of said second asphalt composition and

 an adhesive composition layer contacting a lower surface of the substrate of the first region and a release backing disposed over a bottom surface of said second layer; and

 a second region having

 an upper surface of the substrate of the second region substantially free of the second asphalt composition and

 a lower surface of the substrate of the second region substantially free of the adhesive composition.

(Emphasis Added)

The Applicant again respectfully submits that Simpson fails to disclose all elements of the rejected claim for at least the reasons that follow. Applicant's claim 45 recites, a composite sheet of rolled roofing material comprising a substrate with asphalt layer, granules, adhesive layer, and a release backing. The Office cites to elements in a roll of roofing material (shown in FIG. 1 of Simpson) in addition to elements in a completely separate roll of underlayment (shown in FIG. 9 of Simpson). The Office is attempting to combine two separate sheets of rolled roofing material and cite them as if the structure disclosed were

a combine sheet of material in one substrate. This is clearly not a composite sheet of rolled roofing material made of a substrate with asphalt layer, granules, adhesive layer, and a release backing. Applicant has previously highlighted this anticipation defect multiple times in the record. The Office has plainly ignored the present claim language.

Applicant specifically claims the composite sheet of roofing material having a substrate with asphalt layer, granules, adhesive layer, and a release backing. In addition to the above language, Applicant notes the singular language of the above terms. To take an interpretation that Applicant's claim language can be construed as multiple sheets or substrates is beyond any reasonably broad interpretation of claim language and flatly ignores Applicant's claim language. The anticipation rejections previously submitted with regard to dependent claim 45 should be withdrawn. The Applicant also respectfully submits that no motivation or reference to patent US 4,079,158 to Kennepohl et al. cure the above deficiencies. Accordingly, Applicant respectfully requests allowance of claim 45.

B. Claims 46-54

The Applicant respectfully submits that since claims 46-54

depend on independent claim 45, claims 46-54 contain all limitations of independent claim 45. Since independent claim 45 should be allowed, as argued herein, pending dependent claims 46-54 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

C. Claim 55

Independent claim 55 reads:

A composite roofing material prior to application on a roof comprising:

a substrate saturated with a first asphalt composition having an upper and a lower surface and ***providing unified structure to the composite roofing material;***

a first layer of a second asphalt composition contacting only a first portion of said upper surface of said substrate, wherein said first layer does not contact at least a first region of said upper surface disposed along at least a first edge of said substrate;

a second layer of an adhesive composition contacting only a second portion of said lower surface of said substrate wherein said second layer does not contact at least a second region of said lower surface disposed along said at least said first edge of said substrate;

granules contacting an outer surface of said first layer; and

a release backing disposed over a bottom surface of said second layer.

(Emphasis Added)

The Applicant again respectfully submits that Simpson fails to disclose all elements of the rejected claim for at least the

reasons that follow. Applicant's claim 55 recites, a composite roofing material prior to application on a roof comprising a substrate with asphalt layer, granules, adhesive layer, and a release backing. The Office cites to elements in a roll of roofing material (shown in FIG. 1 of Simpson) in addition to elements in a completely separate roll of underlayment (shown in FIG. 9 of Simpson). The Office has not responded to the present claim language and Applicant's prior arguments as previously discussed with regard to claim 45.

Applicant specifically claims a composite roofing material prior to application on a roof. Applicant additionally breaths life in the preamble by reciting within the body of the claim, "a substrate ... providing unified structure to **the composite roofing material.**" To take an interpretation that Applicant's claim language can be construed as multiple separate sheets or substrates is beyond any reasonably broad interpretation of claim language and flatly ignores Applicant's claim language. The anticipation rejections previously submitted with regard to dependent claim 55 should not apply.

The Applicant respectfully submits that Simpson fails to disclose, teach, or suggest all elements of the rejected claim for

the additional reasons that follow. Applicant's claim 55 recites, a composite roofing material prior to application on a roof comprising: a substrate, a first layer of a second asphalt composition, a second layer of an adhesive composition, granules, and a release backing. The Office references, Simpson disclosure of multiple roofing materials in Figures 10 and 11. Simpson's applied roofing system includes multiple layers of roofing material including one or more a sheets of roofing material (element 10) and as referenced by the Office two layers of underlayment (element 90). This is not a single roofing material with a substrate, a first layer of a second asphalt composition, a second layer of an adhesive composition, granules, and a release backing. At the point of overlap there are total of three different roofing materials: a first layer of underlayment, a second overlapping layer of underlayment and the sheet of roofing material (element 10).

The Office cannot make a consistent argument that the substrate is the same layer of substrate during the point of overlap. The overlapping layer of substrates discloses multiple substrates and cannot be read as disclosing one substrate. The Office also cannot maintain an argument that the roofing material

is merely an aggregate of Simpson's multiple roofing materials. If Simpson were to combine the disclosed multiple roofing materials, which Applicant does not concede one skilled in the art at the time of the invention would have done, the combination would not incorporate the overlapping of the multiple layers of underlayment since the overlap is a product of the joining the two separate underlayments. A combined continuous sheet of underlayement would have no need for overlap. Simpson discloses separate pieces of roofing material and does not provide a single substrate as claimed in Applicant's claim 55.

In addition, the applied roofing system as cited by the Office and disclosed by Simpson, Figures 10 and 11, would not include the release paper. The release paper 96 would be striped to expose the adhesive 94 to the roof surface 98 as the underlayment 90 is rolled along the eave. See Simpson column 5, lines 55-58. The citation to the applied system of Simpson does not disclose a release backing as claimed by Applicant's claim 55.

Therefore the anticipation rejections previously submitted with regard to dependent claim 55 should not apply. The Applicant also respectfully submits that no motivation or reference to patent US 4,079,158 to Kennepohl et al. cure the above deficiencies.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

D. Claims 56-61

The Applicant respectfully submits that since claims 56-61 depend on independent claim 55, claims 56-61 contain all limitations of independent claim 55. Since independent claim 55 should be allowed, as argued herein, pending dependent claims 56-61 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

E. Claim 62

Independent claim 62 reads:

A composite sheet of rolled roofing membrane prior to application on a roof comprising:

a substrate of fibrous material saturated with a first asphalt composition, said substrate having a first section and a second section with a common edge running lengthwise and perpendicular with ***the rolling of the roofing membrane*** wherein the first section has a second asphalt composition layer contacting an upper surface of the first section of the substrate and granules contacting an upper surface of said second asphalt composition layer and an adhesive composition layer contacting a lower surface of the first section of the substrate and a release backing disposed over a bottom surface of said adhesive composition and a second section has ~~an upper surface~~ of the second section of the substrate cleaned of the first asphalt composition and substantially free of the second asphalt composition and a lower surface of the second section of the substrate cleaned of the first asphalt composition and substantially free of the adhesive composition.

(Emphasis Added)

The Applicant again respectfully submits that Simpson fails to disclose all elements of the rejected claim for at least the reasons that follow. Applicant's claim 62 recites, a composite sheet of rolled roofing membrane prior to application on a roof comprising a substrate. The Office cites to elements in a roll of roofing material (shown in FIG. 1 of Simpson) in addition to elements in a completely separate roll of underlayment (shown in FIG. 9 of Simpson). The Office has not responded to the present claim language and Applicant's prior arguments as previously discussed with regard to claim 45.

Applicant specifically claims a composite sheet of rolled roofing membrane prior to application on a roof. Applicant additionally breathes life in the preamble by reciting within the body of the claim, "a common edge running lengthwise and perpendicular with ***the rolling of the roofing membrane.***" To take an interpretation that Applicant claim language can be construed as multiple separate sheets or substrates is beyond any reasonably broad interpretation of claim language and flatly ignores Applicant's claim language. Therefore, the anticipation rejections previously submitted with regard to dependent claim 62

should not apply.

The Applicant respectfully submits that Simpson also fails to disclose, teach, or suggest all elements of the rejected claim for the additional reasons that follow. Applicant's claim 62 recites, a composite sheet of rolled roofing membrane prior to application on a roof comprising a substrate with a first layer of a second asphalt composition, a second layer of an adhesive composition, granules, and a release backing. The Office references, Simpson disclosure of multiple roofing materials in Figures 10 and 11. Simpson's applied roofing system includes multiple layers of roofing material including one or more a sheets of roofing material (element 10) and as referenced by the Office two layers of underlayment (element 90). This is not a single roofing material with a substrate, a first layer of a second asphalt composition, a second layer of an adhesive composition, granules, and a release backing. At the point of overlap there are total of three different roofing materials: a first layer of underlayment, a second overlapping layer of underlayment and the sheet of roofing material (element 10).

The Office cannot make a consistent argument that the substrate is the same layer of substrate during the point of

overlap. The overlapping layer of substrates discloses multiple substrates and cannot be read as disclosing one substrate. The Office also cannot maintain an argument that the roofing material is merely an aggregate of Simpson's multiple roofing materials. If Simpson were to combine the disclosed multiple roofing materials, which Applicant does not concede one skilled in the art at the time of the invention would have done, the combination would not incorporate the overlapping of the multiple layers of underlayment since the overlap is a product of the joining the two separate underlayments. A combined continuous sheet of underlayement would have no need for overlap. Simpson discloses separate pieces of roofing material and does not provide a single substrate as claimed in Applicant's claim 62

In addition, the applied roofing system as cited by the Office and disclosed by Simpson, Figures 10 and 11, would not include the release paper. The release paper 96 would be striped to expose the adhesive 94 to the roof surface 98 as the underlayment 90 is rolled along the eave. See Simpson column 5, lines 55-58. The citation to the applied system of Simpson does not disclose a release backing as claimed by Applicant's claim 55.

Therefore the anticipation rejections previously submitted with

regard to dependent claim 55 should not apply. The Applicant also respectfully submits that no motivation or reference to patent US 4,079,158 to Kennepohl et al. cure the above deficiencies. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejection.

F. Claims 63-66

The Applicant respectfully submits that since claims 63-66 depend on independent claim 62, claims 63-66 contain all limitations of independent claim 62. Since independent claim 62 should be allowed, as argued herein, pending dependent claims 63-66 should be allowed as a matter of law for at least this reason.

In re Fine, 5 U.S.P.Q.2d 1596, 1608 (Fed. Cir. 1988).

III. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

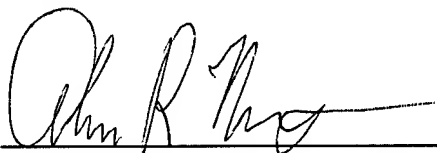
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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 45-66 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

Thomas Zickell

By 
Andrew R. Martin, Esquire
Registration No. 45,413
Attorney for Applicant(s)

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

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